



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,510	12/14/2001	Syunji Sugaya	P/2850-53	4552

2352 7590 12/01/2006

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER

BOVEJA, NAMRATA

ART UNIT PAPER NUMBER

3622

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/018,510	Applicant(s) SUGAYA, SYUNJI	
	Examiner Namrata Boveja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7, 10-18, 21-25, 28-36, 39-43, 46-50, 53 and 54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 3-7, 10-18, 21-25, 28-36, 39-43, 46-50, 53 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 09/14/2006.
2. Claims 3-7, 10-18, 21-25, 28-36, 39-43, 46-50, and 53-54 are presented for examination.
3. Amendments to claims 3-5, 7, 10-12, 15-17, 21-23, 25, 28-36, 39-43, 46-50, and 53-54 have been entered and considered.

Claim Rejections - 35 USC § 112

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

4. Claims 3 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 39 teach a method, system, and program wherein the user side equipment reproduces the said advertisements by "**animation**". Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The

Art Unit: 3622

term "**animation**" in claims 3 and 39 is used by the claim to mean download data over the Internet, reproduce the advertisement using software, and control advertisement scheduling also using the software as interpreted from the applicant specification on page 3 where steps 15, 2, 40, 56, 66, and 86 characterize reproduction of the advertisements by "**animation**", while the accepted meaning of the term "**animate**" is "to make or design in such a way as to create apparently spontaneous lifelike movement or to produce in the form of an animated cartoon" by the Merriam-Webster Online Dictionary (<http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=animate>). The term is indefinite because the specification does not clearly redefine the term.

Therefore, the interpreted description of word from the specification steps above is utilized in examining the application. *The Applicant has not clarified what meaning should be attached to this term and cannot shift between the definition supported by the specification and the definition supported by the dictionary. Applicant needs to make a decision regarding which definition the Applicant wants to follow with regards to this Application. Examiner has rejected both of these definitions in the Office Action that follows. Clarification is required.*

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of

an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 3, 5-6, 10, 17-18, 21, 23-24, 28, 35-36, 39, 42, 46, and 53-54 are rejected under 102(e) as being anticipated by Servan-Schreiber et al (Patent Number 6,892,354 hereinafter Servan-Schreiber).

Disclaimer: *Claim 3 was found to be deficient under U.S.C. 112 second. To the extent the claimed invention was understood, the following art was applied.*

In reference to claim 3, Servan-Schreiber teaches an advertisement presentation system according to comprising: a network (abstract, col. 4 lines 14-19, and col. 5 lines 1-2, Figure 1); a server connected to the network (abstract, col. 1 lines 58-63, col. 2 lines 1-10, col. 3 lines 6-21, and col. 5 lines 21-31); and user side equipment for presenting advertisements to a user while transferring data with said server via said network (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21), wherein said user side equipment is provided with an animated advertisement reproduction section for reproducing said advertisements by animation (i.e. downloading data over the Internet, reproducing the advertisement using software, and controlling advertisement scheduling also using the software) (col.1 lines 47-63, col. 2 lines 49-65, col. 3 lines 6-21 and 44-67, and col. 4 lines 1-6).

6. In reference to claim 5, Servan-Schreiber teaches an advertisement presentation system according to comprising: a network (abstract, col. 4 lines 14-19, and col. 5 lines 1-2, Figure 1); a server connected to the network (abstract, col. 1 lines 58-63, col. 2 lines 1-10, col. 3 lines 6-21, and col. 5 lines 21-31); and user side equipment for presenting advertisements to a user while transferring data with said server via said

Art Unit: 3622

network (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21); and a selection section for selecting one or a plurality of advertisements to present to the user from among a plurality of advertisements based on said personal history information (col.4 lines 50-60), wherein said personal history information comprises: advertisement access history (col. 4 lines 48-60).

7. In reference to claims 6 and 24 Servan-Schreiber teaches a system and program characterized in that said personal history information contains the content or type of data transferred by the user (i.e. what keywords are searched and which sites are accessed), advertisements presented to the user, or the user's personal characteristics information (i.e. statistical profile data) (col.4 lines 50-60).

8. In reference to claim 10, Servan-Schreiber teaches an advertisement presentation system according to comprising: *a network (abstract, col. 4 lines 14-19, and col. 5 lines 1-2, Figure 1); a server connected to the network (abstract, col. 1 lines 58-63, col. 2 lines 1-10, col. 3 lines 6-21, and col. 5 lines 21-31); and user side equipment for presenting advertisements to a user while transferring data with said server via said network (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21); wherein said user side equipment downloads data (i.e. the contents of an advertisement) and software (i.e. it is inherent that you need a web browser to display the webpage advertisement, and if you don't have a browser, it will need to be downloaded to view the advertisement) required to use this data from said server via said network (col. 2 lines 1-5, col. 3 lines 6-16 and 35-43, col. 4 lines 1-6 and 24-31, and Figures 2 and 7).*

Art Unit: 3622

9. In reference to claim 17, Servan-Schreiber teaches an advertisement presentation system according to comprising: *a network (abstract, col. 4 lines 14-19, and col. 5 lines 1-2, Figure 1); a server connected to the network (abstract, col. 1 lines 58-63, col. 2 lines 1-10, col. 3 lines 6-21, and col. 5 lines 21-31); and user side equipment for presenting advertisements to a user while transferring data with said server via said network (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21); wherein transfer speed is adjusted based on the state of presentation of said advertisement while data is transferred between said server and said user side equipment via said network (col. 3 lines 30-67 and col. 4 lines 1-13).*

10. In reference to claim 18, Servan-Schreiber teaches a system for finishing data transfer at the same time as or after presentation of said advertisement is completed (col. 3 lines 30-67 and col. 4 lines 1-13).

11. In reference to claim 21, Servan-Schreiber teaches *a computer program product in a computer readable medium for presenting advertisements, the computer program product comprising: first instructions for transferring data to or from a server via a network (abstract and col. 1 lines 47-57); second instructions for presenting advertisements on a user side equipment to a user while transferring data (col. 1 lines 58-63 and col. 2 lines 6-10); and third instructions for reproducing said advertisements by showing animation on said user side equipment (i.e. downloading data over the Internet, reproducing the advertisement using software, and controlling advertisement scheduling also using the software) (col. 2 lines 49-65, col. 3 lines 6-21 and 44-67, and col. 4 lines 1-6).*

12. In reference to claim 23, Servan-Schreiber teaches *a computer program product in a computer readable medium for presenting advertisements, the computer program product comprising: first instructions for transferring data to or from a server via a network (abstract and col. 1 lines 47-57); second instructions for presenting advertisements on a user side equipment to a user while transferring data (col. 1 lines 58-63 and col. 2 lines 6-10); and third instructions for selecting one or a plurality of advertisements to present to the user from among a plurality of advertisements based on said personal history information (col.4 lines 50-60), wherein said personal history information comprises: advertisement access history (col. 4 lines 48-60).*

13. In reference to claim 28, Servan-Schreiber teaches *a computer program product in a computer readable medium for presenting advertisements, the computer program product comprising: first instructions for transferring data to or from a server via a network (abstract and col. 1 lines 47-57); second instructions for presenting advertisements on a user side equipment to a user while transferring data (col. 1 lines 58-63 and col. 2 lines 6-10); and third instructions for downloading data (i.e. the contents of an advertisement) and software (i.e. it is inherent that you need a web browser to display the webpage advertisement, and if you don't have a browser, it will need to be downloaded to view the advertisement) required to use this data from said server via said network (col. 2 lines 1-5, col. 3 lines 6-16 and 35-43, col. 4 lines 1-6 and 24-31, and Figures 2 and 7).*

14. In reference to claim 35, Servan-Schreiber teaches *a computer program product in a computer readable medium for presenting advertisements, the computer program*

product comprising: first instructions for transferring data to or from a server via a network (abstract and col. 1 lines 47-57); second instructions for presenting advertisements on a user side equipment to a user while transferring data (col. 1 lines 58-63 and col. 2 lines 6-10); third instructions for adjusting transfer speed based on the state of presentation of said advertisement while data is transferred between said server and said user side equipment via said network (col. 3 lines 30-67 and col. 4 lines 1-13).

15. In reference to claim 36, Servan-Schreiber teaches a computer program further comprising: fifth instructions for finishing data transfer at the same time as or after presentation of said advertisement is completed (col. 3 lines 30-67 and col. 4 lines 1-13).

16. **Disclaimer:** *Claim 3 was found to be deficient under U.S.C. 112 second. To the extent the claimed invention was understood, the following art was applied.*

In reference to claim 39, Servan-Schreiber teaches a method of presenting advertisements comprising steps of: a first step for transferring data to or from a server via a network (col. 1 lines 58-63, col. 2 lines 1-5 and 49-65, col. 3 lines 10-16, and Figure 1); a second step for presenting advertisements on a user side equipment to a user while transferring data (*abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21*); and a third step of reproducing said advertisements on said user side equipment by showing animation (i.e. downloading data over the Internet; reproducing the advertisement using software, and controlling advertisement scheduling also using the software) (col.1 lines 47-63, col. 2 lines 49-65, col. 3 lines 6-21 and 44-67, and col. 4 lines 1-6).

Art Unit: 3622

17. In reference to claim 42, Servan-Schreiber teaches a method of presenting advertisements comprising steps of: a first step for transferring data to or from a server via a network (col. 1 lines 58-63, col. 2 lines 1-5 and 49-65, col. 3 lines 10-16, and Figure 1); a second step for presenting advertisements on a user side equipment to a user while transferring data (*abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21*), wherein said personal history information comprises: advertisement access history (col. 4 lines 48-60).

18. In reference to claim 46, Servan-Schreiber teaches a computer program product in a computer readable medium for presenting advertisements, the computer program product comprising: first instructions for transferring data to or from a server via a network (*abstract and col. 1 lines 47-57*); second instructions for presenting advertisements on a user side equipment to a user while transferring data (col. 1 lines 58-63 and col. 2 lines 6-10); and third instructions for downloading data (i.e. the contents of an advertisement) and software (i.e. *it is inherent that you need a web browser to display the webpage advertisement, and if you don't have a browser, it will need to be downloaded to view the advertisement*) required to use this data from said server via said network (col. 2 lines 1-5, col. 3 lines 6-16 and 35-43, col. 4 lines 1-6 and 24-31, and Figures 2 and 7); and fourth instructions for downloading data (i.e. the contents of an advertisement) and software (i.e. *it is inherent that you need a web browser to display the webpage advertisement, and if you don't have a browser, it will need to be downloaded to view the advertisement*) required to use this data from said

server via said network (col. 2 lines 1-5, col. 3 lines 6-16 and 35-43, col. 4 lines 1-6 and 24-31, and Figures 2 and 7).

19. In reference to claim 53, Servan-Schreiber teaches a method of presenting advertisements comprising steps of: a first step for transferring data to or from a server via a network (col. 1 lines 58-63, col. 2 lines 1-5 and 49-65, col. 3 lines 10-16, and Figure 1); a second step for presenting advertisements on a user side equipment to a user while transferring data (*abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21*), and a third step for adjusting transfer speed based on the state of presentation of said advertisement while data is transferred between said server and said user side equipment via said network (col. 3 lines 30-67 and col. 4 lines 1-13).

20. In reference to claim 54, Servan-Schreiber teaches a method further comprising a fourth step for finishing data transfer at the same time as or after presentation of said advertisement is completed (col. 3 lines 30-67 and col. 4 lines 1-13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 3-4, 7, 11-16, 21-22, 25, 29-34, 39-40, and 47-50 are rejected under U.S.C. 103(a) as being unpatentable over Servan-Schreiber in view of Official Notice.

Disclaimer: Claim 3 was found to be deficient under U.S.C. 112 second. To the

extent the claimed invention was understood, the following art was applied.

In reference to claim 3, Servan-Schreiber teaches an advertisement presentation system according to comprising: a network (abstract, col. 4 lines 14-19, and col. 5 lines 1-2, Figure 1); a server connected to the network (abstract, col. 1 lines 58-63, col. 2 lines 1-10, col. 3 lines 6-21, and col. 5 lines 21-31); and user side equipment for presenting advertisements to a user while transferring data with said server via said network (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21), wherein said user side equipment is provided reproducing said advertisements (i.e. downloading data over the Internet, reproducing the advertisement using software, and controlling advertisement scheduling also using the software) (col. 1 lines 47-63, col. 2 lines 49-65, col. 3 lines 6-21 and 44-67, and col. 4 lines 1-6). Servan-Schreiber does not teach the advertisements being animated (i.e. to impart motion or activity to per Dictionary.com, <http://dictionary.reference.com/browse/animated>).

Official Notice is taken that it is old and well known to animate advertisements especially on webpages by imparting motion or activity to a graphic by using things such as blinking, having advertisements float across the monitor, having pop-op advertisements, and changing colors used in advertisements. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include animation in the advertisements to enable advertisers to attract attention to their advertisements by making the advertisements more visible, interactive, and appealing to users.

Art Unit: 3622

22. In reference to claim 4, Servan-Schreiber teaches an advertisement presentation system according to *comprising: a network (abstract, col. 4 lines 14-19, and col. 5 lines 1-2, Figure 1); a server connected to the network (abstract, col. 1 lines 58-63, col. 2 lines 1-10, col. 3 lines 6-21, and col. 5 lines 21-31); and user side equipment for presenting advertisements to a user while transferring data with said server via said network (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21).* Servan-Schreiber is silent about storing personal history information.

Official Notice is taken that it is old and well known to store personal history information in the field of advertising to target advertisements based on personal history information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include storing of the personal history information to enable advertisers to access this information on more than one occasion for targeting appropriate product and services advertisements that will be most valuable to the consumers.

23. In reference to claim 7, Servan-Schreiber teaches an advertisement presentation system according to *comprising: a network (abstract, col. 4 lines 14-19, and col. 5 lines 1-2, Figure 1); a server connected to the network (abstract, col. 1 lines 58-63, col. 2 lines 1-10, col. 3 lines 6-21, and col. 5 lines 21-31); and user side equipment for presenting advertisements to a user while transferring data with said server via said network (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21).* Servan-Schreiber does not teach a system for selecting one or a plurality of

advertisements to present to a user from among a plurality of advertisements based on the environment (i.e. drivers and software installed) of said user side equipment.

Official Notice is taken that is old and well known to present content in different formats based on the user's environment. For example, if the user's computer does not have the software that supports the viewing of a Flash or video presentation, a user may be provided the option to view the information in text or audio format or download the Flash software. As an another example, if the user is using a different version of the Microsoft Word software on his computer, he might be asked to convert a Word file he received in an e-mail in order to be able to view it with the version of Word that is installed on his machine, and this conversion may cause the document to look slightly different on his machine if for example he does not have the same fonts installed on his computer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include presenting content in different formats based on the user's environment to enable advertisers to reach a broad base of target users regardless of the type of computer system the users may be using.

24. In reference to claim 11, Servan-Schreiber teaches an advertisement presentation system according to comprising: *a network (abstract, col. 4 lines 14-19, and col. 5 lines 1-2, Figure 1); a server connected to the network (abstract, col. 1 lines 58-63, col. 2 lines 1-10, col. 3 lines 6-21, and col. 5 lines 21-31); and user side equipment for presenting advertisements to a user while transferring data with said server via said network (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21).* Servan-Schreiber *also* teaches the system characterized in that said user

Art Unit: 3622

side equipment presents the advertisements to the user while downloading data to said server via said network and during idle and wait time (col. 1 lines 47-63, col. 2 lines 1-10 and 49-65, col. 3 lines 22-43, and Figure 5A). Servan-Schreiber does not specifically recite presenting advertisements while uploading data to said server via said network, even though uploading also leads to an idle and wait time.

Official Notice is taken that is old and well known to present advertising content while uploading data to a server via a network to make an effective use of wait time as done by e-mail providers such as Juno when users are waiting to upload file attachments to their e-mail messages to help keep the e-mail service free of charge to the users and to give users something to look at while waiting on their computers for the upload to be completed. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include presenting advertisements during uploading of data to provide the users with targeted advertising for viewing while waiting for the upload to be completed.

25. In reference to claim 12, Servan-Schreiber teaches an advertisement presentation system according to *comprising: a network (abstract, col. 4 lines 14-19, and col. 5 lines 1-2, Figure 1); a server connected to the network (abstract, col. 1 lines 58-63, col. 2 lines 1-10, col. 3 lines 6-21, and col. 5 lines 21-31); and user side equipment for presenting advertisements to a user while transferring data with said server via said network (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21)*. Servan-Schreiber also teaches a system for requesting said user to input information interactively (i.e. user clicks on or manually enters a hyperlink request)

Art Unit: 3622

when data is transferred between said server and said user side equipment via said network (abstract, col. 2 lines 49-65, and Figure 2). Servan-Schreiber is silent about including a step for storing responses input by said input request section.

Official Notice is taken that it is old and well known to store response input information in the field of e-commerce. For example, when a user has an online account with a vendor, the vendor can offer to store the user's credit card information associated with the online account so that the user does not have to re-type in that information each time when the user is making an online transaction. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include storing of response input information (i.e. manually typing in something) to help users save time by automatically filling in this information on any required forms online.

26. In reference to claims 13 and 14, Servan-Schreiber does not teach a system for accessing and retrieving responses stored in said response storage section.

Official Notice is taken that it is old and well known to access and retrieve responses stored in a response storage section in the field of advertising. For example, personal data collected from surveys is stored in a database and is accessed and retrieved for sending e-marketing communication messages such as e-mail blasts targeted to different customer segments such as contractors, distributors, and original equipment manufacturers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include access and

Art Unit: 3622

retrieval of response input information to target advertisements more effectively for users of the services and products.

27. In reference to claim 15, Servan-Schreiber teaches an advertisement presentation system according to *comprising: a network (abstract, col. 4 lines 14-19, and col. 5 lines 1-2, Figure 1); a server connected to the network (abstract, col. 1 lines 58-63, col. 2 lines 1-10, col. 3 lines 6-21, and col. 5 lines 21-31); and user side equipment for presenting advertisements to a user while transferring data with said server via said network (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21)*. Servan-Schreiber does not teach the system for executing sales of products or services to said user while data is transferred to or from said server via said network.

Official Notice is taken that it is old and well known to execute sales of products or services to said user while data is transferred to or from said server via said network. For example, if a user opens up two Internet browser windows, he could be making an online purchase using a credit card and transferring this credit card information to the merchant in one window, and he could be viewing a product advertisement in another window simultaneously while waiting for the credit card transaction to go through. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to execute sales of products or services to said user while data is transferred to or from said server via said network to utilize the user's time more effectively by enabling data transfer and sales execution to take place simultaneously in two different browser windows.

28. In reference to claim 16, Servan-Schreiber teaches an advertisement presentation system according to *comprising: a network (abstract, col. 4 lines 14-19, and col. 5 lines 1-2, Figure 1); a server connected to the network (abstract, col. 1 lines 58-63, col. 2 lines 1-10, col. 3 lines 6-21, and col. 5 lines 21-31); and user side equipment for presenting advertisements to a user while transferring data with said server via said network (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21)*. Servan-Schreiber does not teach a system *with a processing section* for virus checking, defragmenting, or deleting unnecessary files from said user side equipment while data is transferred to or from said server via said network.

Official Notice is taken that it is old and well known to perform a virus check on the user side equipment while data is transferred to or from said server via said network. For example, many companies manage and secure electronic communications by using a software program to check the content of incoming and outgoing e-mails to prevent any viruses from entering user computer systems when a user attaches files to an e-mail message. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to *include a processing section for performing a virus check on the user side equipment while data is transferred to or from said server via said network to prevent any viruses from entering or exiting the user side equipment*.

29. In reference to claim 21, Servan-Schreiber teaches *a computer program product in a computer readable medium for presenting advertisements, the computer program product comprising: first instructions for transferring data to or from a server via a*

network (abstract and col. 1 lines 47-57); second instructions for presenting advertisements on a user side equipment to a user while transferring data (col. 1 lines 58-63 and col. 2 lines 6-10); and third instructions for reproducing said advertisements on said user side equipment (i.e. downloading data over the Internet, reproducing the advertisement using software, and controlling advertisement scheduling also using the software) (col. 2 lines 49-65, col. 3 lines 6-21 and 44-67, and col. 4 lines 1-6). Servan-Schreiber does not teach the advertisements being animated (i.e. to impart motion or activity to per Dictionary.com, <http://dictionary.reference.com/browse/animated>).

Official Notice is taken that it is old and well known to animate advertisements especially on webpages by imparting motion or activity to a graphic by using things such as blinking, having advertisements float across the monitor, having pop-up advertisements, and changing colors used in advertisements. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include animation in the advertisements to enable advertisers to attract attention to their advertisements by making the advertisements more visible, interactive, and appealing to users.

30. In reference to claim 22, Servan-Schreiber teaches a computer program product in a computer readable medium for presenting advertisements, the computer program product comprising: first instructions for transferring data to or from a server via a network (abstract and col. 1 lines 47-57); second instructions for presenting advertisements on a user side equipment to a user while transferring data (col. 1 lines

58-63 and col. 2 lines 6-10). Servan-Schreiber is silent about *third instructions* for storing personal history information.

Official Notice is taken that it is old and well known to store personal history information in the field of advertising to target advertisements based on personal history information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include storing of the personal history information to enable advertisers to access this information on more than one occasion for targeting appropriate product and services advertisements that will be most valuable to the consumers.

31. In reference to claim 25, Servan-Schreiber teaches *a computer program product in a computer readable medium for presenting advertisements, the computer program product comprising: first instructions for transferring data to or from a server via a network (abstract and col. 1 lines 47-57); second instructions for presenting advertisements on a user side equipment to a user while transferring data (col. 1 lines 58-63 and col. 2 lines 6-10)*. Servan-Schreiber does not teach *third instructions* for selecting one or a plurality of advertisements to present to a user from among a plurality of advertisements based on the environment (i.e. drivers and software installed) of said user side equipment.

Official Notice is taken that is old and well known to present content in different formats based on the user's environment. For example, if the user's computer does not have the software that supports the viewing of a Flash or video presentation, a user may be provided the option to view the information in text or audio format or download

Art Unit: 3622

the Flash software. As an another example, if the user is using a different version of the Microsoft Word software on his computer, he might be asked to convert a Word file he received in an e-mail in order to be able to view it with the version of Word that is installed on his machine, and this conversion may cause the document to look slightly different on his machine if for example he does not have the same fonts installed on his computer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include presenting content in different formats based on the user's environment to enable advertisers to reach a broad base of target users regardless of the type of computer system the users may be using.

32. In reference to claim 29, Servan-Schreiber teaches *a computer program product in a computer readable medium for presenting advertisements, the computer program product comprising: first instructions for transferring data to or from a server via a network (abstract and col. 1 lines 47-57); second instructions for presenting advertisements on a user side equipment to a user while transferring data (col. 1 lines 58-63 and col. 2 lines 6-10)*. Servan-Schreiber does not specifically recite *third instructions for presenting advertisements while uploading data to said server via said network*, even though uploading also leads to an idle and wait time.

Official Notice is taken that is old and well known to present advertising content while uploading data to a server via a network to make an effective use of wait time as done by e-mail providers such as Juno when users are waiting to upload file attachments to their e-mail messages to help keep the e-mail service free of charge to the users and to give users something to look at while waiting on their computers for the

Art Unit: 3622

upload to be completed. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include presenting advertisements during uploading of data to provide the users with targeted advertising for viewing while waiting for the upload to be completed.

33. In reference to claim 30, Servan-Schreiber teaches *a computer program product in a computer readable medium for presenting advertisements, the computer program product comprising: first instructions for transferring data to or from a server via a network (abstract and col. 1 lines 47-57); second instructions for presenting advertisements on a user side equipment to a user while transferring data (col. 1 lines 58-63 and col. 2 lines 6-10. Servan-Schreiber also teaches third instructions for requesting said user to input information interactively (i.e. user clicks on or manually enters a hyperlink request) when data is transferred between said server and said user side equipment via said network (abstract, col. 2 lines 49-65, and Figure 2). Servan-Schreiber is silent about fourth instructions for storing responses input by said input request section.*

Official Notice is taken that it is old and well known to store response input information in the field of e-commerce. For example, when a user has an online account with a vendor, the vendor can offer to store the user's credit card information associated with the online account so that the user does not have to re-type in that information each type when the user is making an online transaction. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include storing of response input information (i.e. manually

Art Unit: 3622

typing in something) to help users save time by automatically filling in this information on any required forms online.

34. In reference to claims 31 and 32, Servan-Schreiber does not teach the computer program product comprising fifth instructions for accessing and retrieving responses stored in said response storage section.

Official Notice is taken that it is old and well known to access and retrieve responses stored in a response storage section in the field of advertising. For example, personal data collected from surveys is stored in a database and is accessed and retrieved for sending e-marketing communication messages such as e-mail blasts targeted to different customer segments such as contractors, distributors, and original equipment manufacturers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include access and retrieval of response input information to target advertisements more effectively for users of the services and products.

35. In reference to claim 33, Servan-Schreiber teaches *a computer program product in a computer readable medium for presenting advertisements, the computer program product comprising: first instructions for transferring data to or from a server via a network (abstract and col. 1 lines 47-57); second instructions for presenting advertisements on a user side equipment to a user while transferring data (col. 1 lines 58-63 and col. 2 lines 6-10); third instructions for requesting said user to input information interactively (i.e. user clicks on or manually enters a hyperlink request) when data is transferred between said server and said user side equipment via said*

network (abstract, col. 2 lines 49-65, and Figure 2). Servan-Schreiber does not teach fourth instructions for executing sales of products or services to said user while data is transferred to or from said server via said network.

Official Notice is taken that it is old and well known to execute sales of products or services to said user while data is transferred to or from said server via said network. For example, if a user opens up two Internet browser windows, he could be making an online purchase using a credit card and transferring this credit card information to the merchant in one window, and he could be viewing a product advertisement in another window simultaneously while waiting for the credit card transaction to go through.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to execute sales of products or services to said user while data is transferred to or from said server via said network to utilize the user's time more effectively by enabling data transfer and sales execution to take place simultaneously in two different browser windows.

36. In reference to claim 34, Servan-Schreiber teaches *a computer program product in a computer readable medium for presenting advertisements, the computer program product comprising: first instructions for transferring data to or from a server via a network (abstract and col. 1 lines 47-57); second instructions for presenting advertisements on a user side equipment to a user while transferring data (col. 1 lines 58-63 and col. 2 lines 6-10).* Servan-Schreiber does not teach *third instructions* for virus checking, defragmenting, or deleting unnecessary files from said user side equipment while data is transferred to or from said server via said network.

Official Notice is taken that it is old and well known to perform a virus check on the user side equipment while data is transferred to or from said server via said network. For example, many companies manage and secure electronic communications by using a software program to check the content of incoming and outgoing e-mails to prevent any viruses from entering user computer systems when a user attaches files to an e-mail message. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to *include a processing section for performing a virus check on the user side equipment while data is transferred to or from said server via said network to prevent any viruses from entering or exiting the user side equipment.*

37. **Disclaimer:** *Claim 3 was found to be deficient under U.S.C. 112 second. To the extent the claimed invention was understood, the following art was applied.*

In reference to claim 39, Servan-Schreiber teaches a method of presenting advertisements comprising steps of: a first step for transferring data to or from a server via a network (col. 1 lines 58-63, col. 2 lines 1-5 and 49-65, col. 3 lines 10-16, and Figure 1); a second step for presenting advertisements on a user side equipment to a user while transferring data (*abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21*); and a third step of reproducing said advertisements on said user side equipment (i.e. downloading data over the Internet, reproducing the advertisement using software, and controlling advertisement scheduling also using the software) (col. 1 lines 47-63, col. 2 lines 49-65, col. 3 lines 6-21 and 44-67, and col. 4 lines 1-6). *Servan-*

Schreiber does not teach the advertisements being animated (i.e. to impart motion or activity to per Dictionary.com, <http://dictionary.reference.com/browse/animated>).

Official Notice is taken that it is old and well known to animate advertisements especially on webpages by imparting motion or activity to a graphic by using things such as blinking, having advertisements float across the monitor, having pop-up advertisements, and changing colors used in advertisements. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include animation in the advertisements to enable advertisers to attract attention to their advertisements by making the advertisements more visible, interactive, and appealing to users.

38. In reference to claim 40, Servan-Schreiber teaches a method of presenting advertisements comprising steps of: a first step for transferring data to or from a server via a network (col. 1 lines 58-63, col. 2 lines 1-5 and 49-65, col. 3 lines 10-16, and Figure 1); a second step for presenting advertisements on a user side equipment to a user while transferring data (*abstract*, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21). Servan-Schreiber is silent about the third step for storing personal history information.

Official Notice is taken that it is old and well known to store personal history information in the field of advertising to target advertisements based on personal history information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include storing of the personal history information to enable advertisers to access this information on more than one occasion

Art Unit: 3622

for targeting appropriate product and services advertisements that will be most valuable to the consumers.

39. In reference to claim 47, Servan-Schreiber teaches a method of presenting advertisements comprising steps of: a first step for transferring data to or from a server via a network (col. 1 lines 58-63, col. 2 lines 1-5 and 49-65, col. 3 lines 10-16, and Figure 1); a second step for presenting advertisements on a user side equipment to a user while transferring data (*abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21*). Servan-Schreiber does not specifically recite a third step for presenting advertisements while uploading data to said server via said network, even though uploading also leads to an idle and wait time.

Official Notice is taken that is old and well known to present advertising content while uploading data to a server via a network to make an effective use of wait time as done by e-mail providers such as Juno when users are waiting to upload file attachments to their e-mail messages to help keep the e-mail service free of charge to the users and to give users something to look at while waiting on their computers for the upload to be completed. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include presenting advertisements during uploading of data to provide the users with targeted advertising for viewing while waiting for the upload to be completed.

40. In reference to claim 48, Servan-Schreiber teaches a method of presenting advertisements comprising steps of: a first step for transferring data to or from a server via a network (col. 1 lines 58-63, col. 2 lines 1-5 and 49-65, col. 3 lines 10-16, and

Art Unit: 3622

Figure 1); a second step for presenting advertisements on a user side equipment to a user while transferring data (*abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21*); a *third step* for requesting said user to input information interactively (i.e. user clicks on or manually enters a hyperlink request) when data is transferred between said server and said user side equipment via said network (*abstract, col. 2 lines 49-65, and Figure 2*). Servan-Schreiber is silent about including a fourth step for storing responses input by said input request section.

Official Notice is taken that it is old and well known to store response input information in the field of e-commerce. For example, when a user has an online account with a vendor, the vendor can offer to store the user's credit card information associated with the online account so that the user does not have to re-type in that information each time when the user is making an online transaction. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include storing of response input information (i.e. manually typing in something) to help users save time by automatically filling in this information on any required forms online.

41. In reference to claims 49 and 50, Servan-Schreiber does not teach the method further comprising a fifth step for accessing and retrieving responses stored in said response storage section.

Official Notice is taken that it is old and well known to access and retrieve responses stored in a response storage section in the field of advertising. For example, personal data collected from surveys is stored in a database and is accessed and

retrieved for sending e-marketing communication messages such as e-mail blasts targeted to different customer segments such as contractors, distributors, and original equipment manufacturers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include access and retrieval of response input information to target advertisements more effectively for users of the services and products.

Response to Arguments

42. After careful review of Applicant's remarks/arguments filed on 09/14/2006, the Examiner fully considered the arguments, but they are not persuasive.

43. In reference to claims 3 and 39, the Applicant's amendment still does not address the issue pertaining to the 35 USC § 112 rejection that was held in the previous Office Action. Specifically, *the Applicant has not clarified what meaning should be attached to this term and cannot shift between the definition supported by the specification and the definition supported by the dictionary. Applicant needs to make a decision regarding which definition the Applicant wants to follow with regards to this Application. Examiner has rejected both of these definitions in the Office Action that follows.*

44. In reference to claims 3, 21, and 29, Applicant argues that Servan-Schreiber does not teach or suggest display of an advertisement by animation, a moving picture of any analogous concept. With regards to this, first of all the Applicant has not claimed "a moving picture of any analogous concept" in the claims and is arguing what's not claimed. Secondly, the Examiner respectfully disagrees with the Applicant, since Servan-Schreiber does teach or suggest display of an advertisement by animation in

Art Unit: 3622

light of the Applicant specification (i.e. downloading data over the Internet, reproducing the advertisement using software, and controlling advertisement scheduling also using the software) (col.1 lines 47-63, col. 2 lines 49-65, col. 3 lines 6-21 and 44-67, and col. 4 lines 1-6).

Assuming arguendo that Servan-Schreiber did not teach or suggest display of an advertisement by animation, the 35 USC § 103 rejection introduced above for claim 3 and briefly reproduced here, the Examiner respectfully disagrees with the Applicant, since this rejection still addresses this claim limitation of displaying an advertisement by animation. In reference to this, Official Notice is taken that it is old and well known to animate advertisements especially on webpages by imparting motion or activity to a graphic by using things such as blinking, having advertisements float across the monitor, having pop-up advertisements, and changing colors used in advertisements. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include animation in the advertisements to enable advertisers to attract attention to their advertisements by making the advertisements more visible, interactive, and appealing to users. Hence, the rejections previously held in reference to claims 3, 21, and 29 are maintained.

45. In reference to claims 5, 23, and 41, the Applicant argues that Servan-Schreiber does not teach the feature selecting advertisements based upon personal history information of a user where personal history information comprises personal history, advertisement access history, or reply history information for questions. The Examiner respectfully disagrees with the Applicant and would like to point to col. 4 lines 50-60,

that discloses the use of user's preferences determined for example by the particular content pages that are retrieved and viewed by the user and col. 4 lines 48-60 that discloses the personal history information comprises of the *advertisement access history such that a user looking at cooking related pages (i.e. pages can be the advertisements themselves such as cooking books online), advertisements related to cooking are presented (i.e. an advertisement for kitchen accessories is presented when viewing a cookbook online).*

46. In reference to claims 10, 28, and 46, the Applicant argues that Servan-Schreiber does not disclose the downloading of software, and that it only discloses downloading advertising data. The Examiner respectfully disagrees with the Applicant, since Servan-Schreiber teaches downloading data (i.e. the contents of an advertisement) and software (i.e. *it is inherent that you need a web browser to display the webpage advertisement, and if you don't have a browser, it will need to be downloaded to view the advertisement*) required to use this data from said server via said network (col. 2 lines 1-5, col. 3 lines 6-16 and 35-43, col. 4 lines 1-6 and 24-31, and Figures 2 and 7).

47. In reference to claims 17, 35, and 53, the Applicant argues that Servan-Schreiber does not teach or suggest adjusting the data transfer speed. *The Examiner respectfully disagrees, since Servan-Schreiber teaches adjusting the transfer speed based on the state of presentation of said advertisement while data is transferred between said server and said user side equipment via said network on col. 3 lines 30-67 and col. 4 lines 1-*

48. As disclosed in Servan-Schreiber, a new advertising page is that is downloaded upon instruction does not replace the displayed advertising page until it is sufficiently

downloaded. So, the transfer speed of displaying the new advertising page is adjusted based on how much of it has been downloaded.

49. In reference to the 35 USC § 103 (a) rejections, Applicant states that the statements made in the rejection of the claims are directed to speculation of how certain websites or browsers may or may not be used per pages 9 and 10. This statement in itself does not create any doubt about the rejections. Additionally, a review of pages 9 and 10 did not reveal what issue if any the Applicant is referring to. The statement without reference to any claims and without any rebuttal by the Applicant, does not constitute a proper challenge to the Official Notice, since the Applicant has not said anything regarding that the Applicant was not aware that the claimed elements were well known before the filing of his application and before his invention was developed. Per the Applicant's citing of MPEP 2144.03, "A seasonable challenge constitutes a demand for evidence be made as soon as practicable during prosecution. Thus the applicant is charged with rebutting the well known statement in the next reply after the Office Action in which the well known statement was made." The Applicant has not submitted any rebuttal of the well-known statements. In the paragraph in MPEP 2144.03 immediately preceding the above citing, reference is made to *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) that "Furthermore, the applicant must be given the opportunity to challenge the correctness of such assertions and allegations." Again, the Applicant has not challenged the correctness of the assertions but rather only the use of Official Notice itself. Bald statements such as "rejection of the claims are directed to speculation of how certain websites or browsers

may or may not be used," are not adequate and do not shift the burden to the examiner to provide evidence in support of the Official Notice. Allowing such statements to challenge Official Notice would effectively destroy any incentive on part of the Examiner to use it in the process of establishing a rejection of notoriously well known facts (*In re Boon*, 169 USP 231 (CCPA 1971)). Therefore, the Official Notice is proper and fully supported by the indicated evidence and is maintained.

50. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3622

Point of Contact

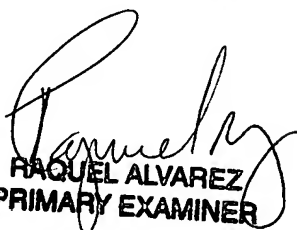
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Eric Stamber can be reached on 571-272-6724. The **Central Fax Number** for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

November 24th, 2006


RAQUEL ALVAREZ
PRIMARY EXAMINER